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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/820,430 | 03/29/2001 | Mitchell M. Jackson | 3085R | 5042 |

7590

08/09/2002

THE LUBRIZOL CORPORATION
Patent Administrator - Mail Drop 022B
29400 Lakeland Boulevard
Wickliffe, OH 44092-2298

EXAMINER

MEDLEY, MARGARET B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1714

6

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-6

Office Action Summary

Application No.
09/820,430

Applicant(s)
JACKSON et al

Examiner
MEDLEY

Group Art Unit
1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 3-11-02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 1
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

The 102(a) rejection over Fuentes-Afflick et al 6203584 B1 is withdrawn in view of Applicant's arguments made of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10, 15, 18 and 19 for reasons made of record in Paper No. 3 dated October 2, 2001 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fuentes-Afflick EPO 947,576 A1 in view of Friihauf 4,129,508 and Black et al WO 93/21,288 B.

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Claims 11, 12 and 16 for reasons made of record in Paper No. 3 dated October 2, 2001 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fuentes-Afflick EPO 947,576 A1 in view of Friihauf 4,129,508 and Black et al WO 93/21,288 B1 as applied to claims 1-10, 15, 18 and 19 above, and further in view of Wayman 3,250,715.

Claims 13, 14 and 17 for reasons made of record in Paper No. 3 dated October 2, 2001 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fuentes-Afflick EPO 947,576 A1 in view of Friihauf 4,129,508 and Black et al WO 93/21,288 B1 as applied to claims 1-10, 15, 18 and 19 above, and further in view of Schilowitz 5,094,667, Pierce-Ruhland 5,407,453, Malfer et al 5,967,988 and Moreton 5,876,468.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 for reasons made of record in Paper No. 3 dated October 2, 2001 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bloch et al WO 93/21,288.

In response to applicant's argument that Black is silent to subject related to fuel and does not disclose the solvent of the claimed invention, the fact that applicant has recognized another advantage which would flow naturally from following the teachings of the prior art cannot be the basis for patentability when the claims are anticipated.

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The instant claims contain the term "solvent" that is anticipated by the lubricant oil that it is known as mineral oil, a well-known conventional solvent.

It is the examiner's position that the phrase "gasoline" has been given patentable weight, however the claims does not require gasoline and only require an alkoxyated amine, pages 24-25 of Bloch, a partial ester having at least one free hydroxyl group and formed by reacting at least one fatty carboxylic acid and at least one polyhydric alcohol, pages 24 and 25 of Bloch and the third paragraph of page 9, and a solvent, the first paragraph of page 3 of Bloch wherein the additive is added to a lubricant oil, e.g. paraffin oil (a mineral oil), the bridging paragraph of pages 9 and 10. It is further noted that the additives of Bloch are the same glycerol mono-oleate and diethoxylated tallow amine used in the experimental results of Tables 1-3 found on pages 9 and 10 of the instant application. Thus the instant claimed additive composition is anticipated by the teachings of Bloch.

In response to applicant's argument that Bloch does not teach a gasoline additive, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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In response to applicant's argument that Fuentes-Afflick and Friihauf in combination do not teach or suggest the instant claimed additive, concentrate, fuel composition and method, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is noted on record that the instant claims are open-ended and would not exclude the additives of Friihauf. Further Fuentes-Afflick provides for the further inclusions of demulsifiers, page 10, line 32

In response to applicant's argument that the combination of Fuentes-Afflick and Bloch does not teach the instant claimed concentrate, fuel and method, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The primary references provide the teaching for the use of the additive and fuel and method in gasoline and having use in gasoline engines. Bloch teachings are set forth supra. Further, Fuentes-Afflick teaches that the additive may be formulated as a concentrate with a solvent, page 10, lines 26-54.

In response to applicant's argument that Wyman does not teach a polymeric pour point depressant, the fact that applicant has recognized another advantage, which would flow naturally from following the suggestion of the prior art cannot be the basis for

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patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The examiner maintains the position that it would be obvious to include the pour point depressant in the concentrate, fuel and method that contain solvents that encompass lubricant oils. Further Fuentes-Afflick provides for the inclusion of conventional additives added to gasoline, page 10, and lines 34-37.

In response to applicant's argument that the tertiary references with the primary reference does not teach the instant claimed invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The tertiary references are maintained for teaching specific detergent additives. The examiner's maintains the position that Fuentes-Afflick in view of Friihauf and Bloch render claims 1-10, 15, 18 and 19 obvious.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The prior art cited by Applicants on Form PTO-1449, Paper No. 7, dated July 02, 2002 have been reviewed, considered and made of record. However, the newly cited

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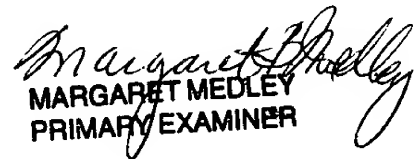
prior art appears to be a duplication of the relied on prior art and thus no new art rejection has been made over the newly cited prior art.

Any inquiry concerning this communication from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can generally be reached on Monday--Friday from 7:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh
August 8, 2002


MARGARET MEDLEY
PRIMARY EXAMINER